

## **REMARKS/ARGUMENTS**

Claims 8-13, 15-26 and 28-30 are pending in the present application. Claims 8, 15, and 19-21 have been amended by this Amendment. Claims 1-7, 14 and 27 have been canceled without prejudice or disclaimer. New claims 28-30 have been added by this Amendment.

### **Claim Rejections under 35 USC § 103**

Claims 8-14 and 20-27 stand rejected under 35 USC § 103(a) as being unpatentable over Shieh et al. (U.S. Pat. No. 6,591,098, hereinafter “Shieh”) in view of MCI Communications Corporation (WO 97/01253, hereinafter “MCI”). Claim 15 stands rejected under 35 USC § 103(a) as being unpatentable over Shieh in view of Shannon et al. (U.S. Pat. No. 6,285,869, hereinafter “Shannon”). Claims 16-19 stand rejected under 35 USC § 103(a) as being unpatentable over Shieh and Shannon in view of MCI. Applicants respectfully traverse these rejections.

### **Summary of subject matter disclosed in the specification**

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations, which are unclaimed.

Applicants’ disclosed embodiments are directed to a remote SIM card activation process when, for example, an old SIM card is being replaced by a new SIM card that can handle different and/or additional services for a particular subscriber. The old account is to be deactivated in favor of the new account being activated. In the prior art, information for the new account is pre-stored on the network in anticipation of its eventually being activated. However,

this occupies considerable network resources even though the account remains inactive. It is preferable to use a “just-in-time” approach where minimal network resources are required as long as the new account remains inactive.

In accordance with disclosed embodiments of the present invention, the old SIM card contains account information for the old account, such as the account identifier. The new SIM card contains account information for the new account, such as a one-time account identifier, designed for a one-time logon to the network, and a new permanent account identifier intended to replace the old account identifier. This new permanent account identifier is not stored on the network at this point, thereby requiring no network resources. It is stored only on the new SIM card. The existing account information is copied from the old SIM card to the new SIM card by a suitable copying device.

The new SIM Card authenticates itself with the network using the one-time account identifier. Upon successful logon to the network using the one-time account identifier, an Auto-Activation application in the new SIM card sends out an Activation Request to the network. The application sends information that includes, for example: the old account identifier copied from the old SIM card and the new permanent account identifier that is to be enabled. It is only at this point that the network stores the new permanent account identifier.

Upon successful sending of the Activation Request, the following operation occurs within the new SIM card. The Auto-Activation application exchanges the one-time account identifier with the permanent account identifier. Accordingly, the new SIM card automatically activates itself and exchanges the permanent parameter in place of the one-time parameter upon successful logon to the network. This is accomplished without receiving the permanent account identifier or other any instruction from the network. Moreover, it is done by storing the new account

information on the network "just-in-time", and not earlier, to thereby make efficient use of network resources only when they are actually needed, i.e. only upon the new account being activated for the new SIM card.

Accordingly, Applicants' disclosed embodiments are not required to provision all the account information into various network systems before activation. The activation will instead be done in a "just-in-time" fashion which greatly saves space on the network, and the use of the one-time account identifier thus eases the number of activated subscriptions required to be stored by the network. Moreover, Applicants' disclosed embodiments use the same one-time account identifier for every account. That is, for a plurality of different new SIM cards intended for use on the network, each of the new SIM cards uses the same one-time account identifier. This produces further efficiencies in terms of the use of network resources.

#### Arguments

Independent claim 8 has been amended to include the features of now canceled claim 14 and recites, *inter alia*, the following:

"b) exchange the one-time account identifier with the permanent account identifier in the subscriber identifying module upon successful logon to the network as the active account identifier in a first data processing device; and

c) upon successful logon to the network, send an activation request for deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module and activating the permanent account identifier attached to the first data processing device,

wherein the step b) is performed *in said first data processing device by means of an auto-activation application* executed after receiving a message from the network informing a successful logon."

The art cited by the Examiner fails to disclose, teach or suggest the features of Applicants' independent claim 8.

Shieh discloses a system and a method for activating a subscriber identification module (SIM) based mobile device in a PCS/ANSI type wireless network. The method of Shieh includes preprogramming the SIM card of the mobile device with temporary activation identifiers, such as an international mobile station identity (IMSI) and/or a mobile identification number (MIN), and a temporary electronic serial number (ESN). The temporary ESN, rather than the mobile device actual ESN, is used to identify the mobile device during registration and activation. The network identifies the temporary ESN associated with the SIM vendor and invokes an over-the-air activation procedure especially for the SIM card mobile devices. A SIM-over-the-air-activation processor is notified to perform the activation for that mobile device on the PCS wireless network. Authentication of the mobile device may be bypassed and the mobile device is instructed to transmit its actual electronic serial number for future registrations (See Abstract of Shieh). More specifically, Shieh explains at col. 7, lines 3-6 that “After activation, the network instructs (214) the mobile device to transmit the actual electronic serial number (ESN) for future registrations. This is accomplished by setting the usage indicator [in the SIM] to send the actual ESN in the future.” Shieh then further teaches in the following step 216 that the method finally comprises overwriting the temporary network activation identifiers so that the actual electronic serial number of the mobile device is not reported to the network until the over-the-air activation is completed.

Shieh requires that the network invoke the over-the-air activation procedure so that the actual electronic serial number (ESN) is set to be transmitted for future registrations and the temporary network activation identifiers are overwritten with the actual network activations identifiers in the SIM. The SIM of Shieh does not automatically activate itself upon logon with the temporary ESN such that a one-time account identifier is exchanged for a permanent account

identifier in the SIM. In contrast to Applicants' claimed invention, Shieh requires that the network invoke the over-the-air activation procedure before the temporary network activation identifiers are overwritten in the SIM. Shieh accordingly fails to disclose, teach or suggest "wherein the step b) is performed *in said first data processing device by means of an auto-activation application* executed after receiving a message from the network informing a successful logon", as expressly recited by Applicants' independent claim 8.

Even assuming, *arguendo*, the Examiner's proffered combination of Shieh, MCI and Shannon (which Applicants do not concede), MCI and Shannon fail to cure the deficiencies of Shieh discussed above with respect to Applicants' independent claim 8.

MCI discloses a personal servicing communication network that is configured to allow a subscriber to use a replacement SIM card by merely inserting the replacement card into one of a plurality of network communication terminals, with the network automatically disabling the old SIM card and enabling the replacement SIM card for subsequent use. A Home Location Register (HLR) and an Authentication Center (AuC) are pre-provisioned by an administrator to correlate an identifier of the replacement SIM card with an identifier of the original SIM card for allowing the subscriber to access the network. Upon first use of the replacement SIM card, the network disables the original identifier in the Home Location Register (HLR) and in the Authentication Center (AuC) so that subsequent access to the network by the subscriber is available solely by use of the replacement SIM card (See Abstract of MCI).

MCI fails to disclose, teach or suggest exchanging a one-time account identifier with a permanent account identifier in a SIM, let alone that this exchange is performed in the SIM by means of an auto-activation application executed after a successful logon. To the contrary, MCI is merely directed to a completely new replacement SIM containing only a replacement identifier

that is correlated to the original SIM in the HLR and AuC. That is, there is no teaching or suggestion of an exchange of a one-time identifier for a permanent identifier in the SIM of MCI, let alone of an auto activation application executed for the exchange of identifiers in the SIM of MCI.

Shannon simply discloses a method for performing replacement of a SIM in a mobile communications network. In the mobile communications network of Shannon, each subscriber is allocated a unique identity code and is provided with a SIM card bearing that code which provides subscriber access to the system. A list of identity codes together with corresponding subscriber details are stored in a first store. When a card is to be replaced, a new identity code is created for the subscriber and is stored in the first store and in a second store. A mapping is provided between the new identity code and the corresponding existing subscriber identity code. The new identity code is then associated with the corresponding subscriber details and is activated while the existing code is de-activated (See Abstract of Shannon).

Shannon therefore likewise fails to disclose, teach or suggest exchanging a one-time account identifier with a permanent account identifier in a SIM, let alone that this exchange is performed in the SIM by means of an auto-activation application executed after a successful logon.

MCI and Shannon fail to teach the above-described features that Shieh lacks, and thus fail to remedy the above-described deficiencies of Shieh. Independent claims 15, 20 and 21 recite limitations similar to at least some of those in independent claim 8 and are, therefore, deemed to be patentably distinct over Shieh, MCI and Shannon for at least those reasons discussed above with respect to independent claim 8.

In view of the foregoing, it is clear that Shieh, MCI and Shannon, whether taken alone or in combination, fail to disclose, teach or suggest the subject matter now recited in independent claims 8, 15, 20 and 21. Accordingly, claims 8, 15, 20 and 21 are deemed to be patentable over Shieh, MCI and Shannon under 35 U.S.C. §103(a).

Claims 9-13, 16-29 and 22-26, which respectively depend from one of independent claims 8, 15 and 21, incorporate all of the limitations of the corresponding independent claim and are, therefore, deemed to be patentably distinct over Shieh, MCI and Shannon for at least those reasons discussed above with respect to independent claims 8, 15 and 21.

#### Dependent Claim 19 and New Claims 28-30

Dependent claim 19, which has been amended herewith, and new claims 28-30, which have been added herewith, recite “wherein the one-time account identifier is the *same* for *a set of subscriber identifying modules* in the network”, which the art cited by the Examiner fails to disclose, teach or suggest.

The Examiner acknowledges at pages 28-29 of the Office Action that Shieh and Shannon fail to disclose “wherein the one-time account identifier is the same for a set of data processing devices in the network”. The Examiner instead relies on MCI to assert that when the replacement SIM card of MCI is inserted into any available terminal, its IMSI parameter (one-time parameter) will be the same for any of the chosen terminals. MCI, however, fails to disclose, teach or suggest that the IMSI of a set of replacement subscriber identifying modules in the network is the same. That is, while the same individual SIM of MCI may be inserted into any of a plurality of available terminals, MCI fails to teach or suggest that a plurality of different SIMs have the same one-time parameter account identifier. To the contrary, none of the art cited

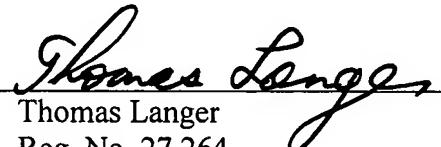
by the Examiner teaches or suggests the use of the same one-time parameter account identifier for all accounts such that even if there is a plurality of subscriber identifying modules, each of the subscriber identifying modules uses the same one-time account identifier. The art cited by the Examiner accordingly fails to disclose, teach or suggest “wherein the one-time account identifier is the *same* for *a set of subscriber identifying modules* in the network”, as expressly recited by Applicants’ dependent claims 19 and 28-30. Claims 19 and 28-30 are accordingly deemed to be patentably distinct over the cited art for at least the foregoing reasons.

#### CONCLUSION

This application is now believed to be in condition for allowance, and early notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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